

## **REMARKS**

This application has been reviewed in light of the Office Action mailed January 3, 2006. Reconsideration of this application in view of the below remarks is respectfully requested.

Claims 1 - 24 are pending in the application with Claims 7, 8 and 10 – 13 having been previously withdrawn from consideration. By the present amendment, Claims 1, 3, 16, 18 and 21 are amended. No new subject matter has been introduced into the disclosure by way of the present amendment.

### **I. Objection to Claims 1, 3, 16, 18 and 21**

The Examiner has objected to Claims 1, 3, 16, 18 and 21 because of informalities. Specifically, the present Office Action suggests that the phrase “a motion image” recited in lines 3 and 7 – 8 of Claim 1 and in lines 4, 8 – 9 and 14 of Claim 16 should be changed to recite “the motion image”. Additionally, the phrase “an image” recited in line 6 of Claim 1 should be changed to “the image”. Further, the phrase “a still image” recited in lines 7 – 8 of Claim 1 and in lines 4, 5, 9 and 15 of Claim 16 should be changed to recite “the still image”. Furthermore, the phrase “the display apparatus” recited in line 2 of Claim 3 should be changed to “the display device”. Still further, the phrase “the recording circuit” recited in line 15 of Claim 16 and in lines 5 – 6 of Claim 18 should be changed to “the recording processing circuit”. Finally, the phrase “the resultant signal” in line 3 of Claim 21 should be changed to “a resultant signal”.

In response, appropriate corrections have been made to Claims 1, 3, 16, 18 and 21 based on the Examiner’s suggestions. Accordingly, Applicants respectfully request withdrawal of the objection to Claims 1, 3, 16, 18 and 21.

## **II. Rejection of Claims 21 and 24 Under 35 U.S.C. § 102(b)**

Claims 21 and 24 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,755,873 Kobayashi.

Kobayashi discloses an endoscope system that allows a user to display and record still images as well as display video. However, Kobayashi does not disclose Applicants' claimed limitation of a displayed state judging step for judging the state of an image displayed on a display device and a recording mode setting step for setting a recording mode according to the result of a judgment at the displayed state judging step. Kobayashi simply discloses that a user can select one of a number of functions (i.e., freeze-picture observation, still-photographing, video recording, and optical disk) by actuating one of a number of switches (see: col. 5, lines 5 – 19 and 30 – 40).

It is well-settled by the Courts that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company, et al., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984).

Therefore, as demonstrated above, because Kobayashi does not disclose each and every element recited in the present claims, Applicants respectfully submit that the rejection has been obviated. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 1 and 24 under 35 U.S.C. § 102(b).

## **III. Rejection of Claims 1 – 2, 6, 16 – 17, and 19 – 20 Under 35 U.S.C. § 103(a)**

Claims 1 – 2, 6, 16 – 17, and 19 – 20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,270,810 issued to Nishimura in view of Kobayashi.

As mentioned above, Kobayashi fails to disclose a recording control circuit for, when the remote controller instructs image recording, judging the state of an image displayed on the display device and setting a recording mode of the recording processing circuit according to the judged state. Nishimura fails to disclose this feature of Applicants' claimed invention as well. Consequently, Nishimura and Kobayashi, taken alone or in any proper combination, fail to disclose or suggest Applicants' invention as recited in Claim 1, and similarly in Claim 16.

Therefore, for at least the reasons given above, Claims 1 – 2, 6, 16 – 17, and 19 – 20 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 1 – 2, 6, 16 – 17, and 19 – 20 under 35 U.S.C. § 103(a) over Nishimura in view of Kobayashi.

#### **IV. Rejection of Claims 3, 4, 5, 9, 14, 15, 18, 22 and 23 Under 35 U.S.C. § 103(a)**

Claims 3, 4, 5, 9, 14, 15, 18, 22 and 23 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Nishimura in view of Kobayashi and/or further in view of U.S. Patent No. 6,968,119 issued to Kaku, U.S. Patent No. 6,059,718 issued to Taniguchi et al., U.S. Patent No. 5,825,982 issued to Wright et al. U.S. Patent No. 5,260,795 issued to Sakai et al. or U.S. Patent No. 6,243,531 issued to Takeuchi et al.

However, as these claims depend from independent Claims 1, 16 and 21, Claims 3, 4, 5, 9, 14, 15, 18, 22 and 23 include all the limitations of those independent claims.

Kaku, Taniguchi et al., Wright et al., Sakai et al., and Takeuchi et al. fail to overcome the deficiencies cited above with regards to Nishimura and Kobayashi. Consequently, Nishimura, Kobayashi, Kaku, Taniguchi, Wright, Sakai, and Takeuchi, taken alone or in any proper combination, fail to disclose or suggest Applicants' invention as recited in Claims 1, 16 and 21.

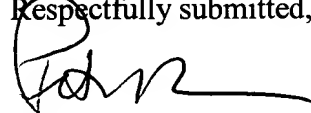
Therefore, for at least the reasons given above for Claims 1, 16 and 21, Claims 3, 4, 5, 9, 14, 15, 18, 22 and 23 are patentably distinct and allowable over the cited prior art. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 3, 4, 5, 9, 14, 15, 18, 22 and 23 under 35 U.S.C. § 103(a) over Nishimura in view of Kobayashi and further in view of Kaku, Taniguchi et al., Wright et al., Sakai et al., or Takeuchi et al.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1 – 6, 9 and 14 – 24 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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